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## 2016 – Study Question (Designs)

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Requirements for protection of designs

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### I. Current law and practice

1) Does your Group's current law provide for an intellectual property right (registered or patented) that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

As set out in the Study Guidelines, copyrights and trademarks are not such rights in the context of this Study Question.

yes

Please explain:

yes, the Swedish Design Protection provides for such protection. The Swedish Design Protection Act is based on the Community Design Regulation EC No 6/2002 ("CDR")

2) If yes, what is this right called? (e.g. registered design, design patent, industrial design, industrial design patent)

References to design below are to be read as references to this right, irrespective of what it is called in your jurisdiction.

Registered Design

3) What are the statutory requirements for such right? Please tick any relevant boxes and explain the basis and application of these requirements.

a)

novelty

The requirements are that the design is new and has individual character. A design is new if no identical design has been made available to the public before the date of filing or - if applicable - the date of priority of the design. Further, a design shall not be considered to have been made available to the public if it has become available within a period of 12 months before these dates by the designer, by a third party as a consequence of information provided or action taken by the designer or as a consequence of abuse vis a vis the designer.

b) non-obviousness

c) inventive step

d) individual character

The requirements are as mentioned above that the design is new and has individual character. A design is considered to have individual character if the overall impression it produces on the informed user is different from any design available to the public prior to the date of filing or - if applicable - the date of priority of the design.

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

4) Does your Group's current law deny design protection to a design with an appearance that is dictated solely by its function?

yes

Please explain:

Yes, according to Section 4 a Swedish Design Act "a design right may not include such details in the appearance of a product which are dictated solely by the technical function of that product".

5) If yes, what are the relevant factors to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

All factors stated in this question can be relevant factors when determining whether a design is unprotectable as functional in Sweden.

a) and b) are stated as factors that may lead to that the design is unprotectable, see question 4) above. The Swedish legislation focuses on details of the overall appearance that are dictated solely by their technical functions - such details cannot be covered by design rights. The existence of functional

details of a product does not necessarily lead to that the overall appearance of the product cannot be protected by a design right, however such details should be set aside when assessing whether or not the overall appearance of the product is protectable. Even details that are deemed to mainly have a functional purpose may be protected. However, the existence of such details does not prevent remaining part of the product to be protected if they meet the basic requirements. If the remaining parts of the product provide for a new and distinctive overall appearance of the product, the overall appearance of the product may be design protected, see Judgment of the General Court (Fifth Chamber), 21 May 2015, joint cases T 22/13 and T 23/13 (mainly section 101) and section 14 of the preamble of the directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs. A product that is designed primarily for its functionality and in which the design and appearance therefore is secondary, may be protected by design right, see Office for Harmonization in the Internal Market, Marzena Karczmarek, Agrotop-Karczmarek/Weremczuk FMR sp. z.o.o case R 971/2011-3 (mainly section 28). The OHIM Board of Appeal has stated that a product's design as a whole is unprotectable as a design only if all the essential details/features of the product's appearance are dictated solely by their technical function, Dr. Oetker Polska Sp. z o.o./ Zakład Produkcyjno - Handlowy "TROPIC" case R 1114/2007-3.

b) whether each portion of the overall appearance is dictated solely by its technical function

See above

c) the availability of alternative appearances that can obtain the same functional result

As said above all factors stated in this question can be relevant factors when determining whether a design is unprotectable as functional in Sweden.

Only details dictated *solely* by the technical function of a product are exempted from protection. Hence, in determining *sole* functionality the existence of alternative appearances for achieving the same technical function is of importance. The availability of alternative appearances that can obtain the same functional result has in Swedish case law – second instance - been ruled as a relevant factor for a design to be protectable, see the Swedish Göta Court of Appeal case T 1519-12 (2013-05-16) and the Swedish Court of Appeal for Western Sweden case T 1519-12 (2012-06-08). The courts argued that a functional design may be subject to design protection, provided that the same technical solution can be achieved by variations in the design of the product. In this ruling the court did not take OHIM's ruling from 2008 (see below) into consideration.

The OHIM Board of Appeal has stated that it cannot be used as an argument for protection that alternative product configurations that could achieve the same function exist. The mere fact that a design alternative exists does not mean that a product's appearance has been dictated by anything other than technical considerations. If protection would be possible based on that there are alternative designs, this would mean that all alternative design solutions could be subject of a design registration, possibly held by the same person, which would have the consequence that no one else would be able to manufacture a competing product capable of performing the same technical function, see Nordson Corporation/UES AG case R 211/2008-3.

The Advocate General argued before the Court of Justice of the European Union ("CJEU"), in the Philips/Remington case (C-299/99), that a product should be protectable by design right if the same technical function could be achieved by another different design. However, the CJEU did not state so in its ruling.

- d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

Based on statements in case law and literature it can not be excluded that the purpose of the choice of design from a functional point of view may have significance. The need to achieve the product's technical function as the only relevant factor when the design in question was selected has been brought up by the OHIM Board of Appeal as a relevant factor for a design to be unprotectable, see Lindner/Franssons case R 690/2007-3, Nordson Corporation/UES AG case R 211/2008-3 and Dr. Oetker Polska Sp. z o.o./ Zakład Produkcyjny - Handlowy "TROPIC" case R 1114/2007-3 and the Swedish Supreme Administrative Court has historically in a number of decisions refused protection for utility designs based on the conclusion that the design was too unskilled and completely conditioned by the intended use. However, according to recent case law the courts are more inclined to rely on the assessment whether the design is solely functional based on the scope of variation (the multiplicity of forms theory), and not based on the purpose or the esthetic performance. See e.g. in this regard judgments by the Swedish Court of Appeal (Hovrätten för västra Sverige, case T-3469-09, and Göta Hovrätt, case T 1519-12) where the courts relied on the multiplicity of forms theory.

- e) other, namely ...

The Swedish Supreme Administrative Court has in rulings from the early 80's ruled that, for a product to be protected by design right, the design must - to some degree - be qualified and given special care, see case RÅ 1982 2:22 and case RÅ 1984 2:65

- 6) Does your Group's current law deny design protection to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

However, the existence of such solely functional portions does not prevent remaining design details of the product to be protected if they meet the basic requirements. The excluded details are not specifically mentioned or dealt with in the grant of protection. The restriction of functional design applies to the overall appearance of a design such as defined by the applicant. Functional details (e.g. a feature/element) may not be covered by the scope of protection but does not prevent the overall appearance of a design from being registered if it meets the basic requirements of novelty and distinctive character. If the applicant applies for protection to any solely functional feature or element only, such design is not entitled to design protection. Please note that there may be considerations under the must match/must fit doctrine that also effects the assessment regarding design protection. However such rules are outside the scope of this Study.

- 7) If yes, what are the relevant factors to determine whether or not a portion is deemed functional? Please tick any relevant boxes and explain as applicable:

- a) whether the overall appearance is dictated solely by its technical function

see 5a)

- b) the availability of alternative appearances for the portion to obtain the same functional result

see 5 c)

c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

See 5 d)

d) other, namely ...

8) What is the effect on the scope of protection of a design with one or more functional portions? Please tick any relevant boxes and explain as applicable:

a) any portions deemed functional will not be taken into account when assessing infringement

See answer to question 6.

b) any portions deemed functional will not be taken into account when assessing validity

See answer to question 6.

c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison

See answer to question 6.

d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison

See answer to question 6.

e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)

See answer to question 6.

f) the Group's current law is unsettled

g) other, namely ...

## II. Policy considerations and possible improvements to your current law

9) How can the following aspects of your Group's current law be improved, if at all?

a) the definition or meaning of a "design"

Our view is that the Swedish legislation (and EU-legislation) is sufficiently clear.

b) the requirements for protection of a design

Our view is that the Swedish legislation (and EU-legislation) is sufficiently clear.

c) the treatment of functionality in the sense described in paragraph 14) of the Study Guidelines or aspects of such functionality

Our view is that the Swedish legislation (and EU-legislation) is sufficiently clear.

10) Are there any other policy considerations and/or proposals for improvement to your current law falling within the scope of this Study Question?

no

Please explain:

It is our view that the Swedish legislation (and EU-legislation) is sufficiently clear.

### III. Proposals for harmonisation

11) Does your Group consider that harmonisation in the three areas in question 9) above is desirable?

If yes to some but not all of those three areas, please state in relation to which of the areas your Group considers harmonisation is desirable.

If yes in relation to any of those areas, please respond to the following questions without regard to your Group's current law.

Even if no in relation to any of those areas, please address the following questions to the extent your Group considers your Group's current law could be improved.

yes

Please explain:

Yes, harmonization, in all three areas, also beyond the EU is desirable as the design-right creates a monopoly to products used globally.

12) Should there be harmonisation of the definition of an intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture?

yes

Please explain:

Yes, that would be desirable.

13) If so, what should that right be called?

Design-right would be a good term but we can see no absolute need for the right having the same name in all jurisdictions as long as the protection is available and harmonized.

14) What should the requirements for such right be? Please tick any relevant boxes and explain the basis and application of these requirements:

a) novelty

The Group find it sufficient if the requirements are novelty and individual character.

b) non-obviousness

c) inventive step

d) individual character

The Group find it sufficient if the requirements are novelty and individual character.

e) originality

f) aesthetic

g) ornamental

h) other, namely ...

15) Should design protection be denied to a design with an appearance that is dictated solely by its function?

yes

Please explain:

16) If yes, what should the relevant factors be to determine whether or not a design is deemed unprotectable as being functional? Please tick any relevant boxes and explain as applicable:

a) whether the overall appearance is dictated solely by its technical function

All factors should be relevant when determining functionality.

- b) whether each portion of the overall appearance is dictated solely by its technical function

All factors should be relevant when determining functionality.

- c) the availability of alternative appearances that can obtain the same functional result

All factors should be relevant when determining functionality.

- d) the need to achieve the product's technical function was the only relevant factor when the design in question was selected

All factors should be relevant when determining functionality.

- e) other, namely ...

- 17) Should design protection be denied to any portions (e.g. a "feature", "element") of the overall design that are deemed functional?

yes

Please explain:

- 18) If yes, what should the relevant factors be to determine whether a portion of a design is functional? Please tick any relevant boxes and explain as applicable:

- a) whether the overall appearance is dictated solely by its technical function

The same factors should be applicable when determining functionality of the portions of the design as regarding the design as a whole.

- b) the availability of alternative appearances for the portion to obtain the same functional result

The same factors should be applicable when determining functionality of the portions of the design as regarding the design as a whole.

- c) the need to achieve the product's technical function was the only relevant factor when the portion in question was selected

The same factors should be applicable when determining functionality of the portions of the design as regarding the design as a whole.

- d) other, namely ...

- 19) What should the effect be on the scope of protection of a design with one or more functional portions?



Please tick any relevant boxes and explain as applicable:

- a) any portions deemed functional will not be taken into account when assessing infringement
- b) any portions deemed functional will not be taken into account when assessing validity
- c) any portions deemed functional will not be taken into account separately when assessing infringement, but can play a role in the overall comparison
- d) any portions deemed functional will not be taken into account separately when assessing validity, but may play a role in the overall comparison
- e) no effect (e.g. so long as the overall appearance is not dictated solely by its technical function, all portions of the design are included in the scope of protection, irrespective as to whether any portions may be functional)
- f) the Group's current law is unsettled

Factors c), d) and e) above are relevant in the group's opinion, however as few of them have been tried in case law in Sweden we feel the current law somewhat unsettled. A Swedish court is likely to be of the opinion that a design does not infringe a registered design if the only similarities between the designs are portions that are functional. Whether a portion is functional or not should be determined by taking the perspective of the informed user.

g) other, namely ...

20) If your answer to question 11) is no, is it your Group's view that a (registered or patented) intellectual property right that specifically protects the outward appearance or ornamentation of an object or article of manufacture should not be available at all?

no

21) If yes, why?

N/A

22) If your answer to question 11) is no in relation to some but not all of the three areas set out in question 9) above, please state why your Group does not consider that harmonisation in that area(s) is desirable.

N/A

23) Please comment on any additional issues concerning any aspect of the definition and requirements for protection of designs, or the role of functionality, you consider relevant to this Study Question.

In Swedish Law there is an uncertainty regarding the validity of our rulings from the time before the EU-harmonization. In the doctrine it is considered that the rulings for example mentioned in our answer to question 5 e) still holds a value. However future rulings from the Court of Justice of the European Union (“CJEU”) may very well cover these issues and make the Swedish rulings obsolete.

An issue to be addressed is also that it seems that there is an underuse of the design protection in Sweden. Design itself is considered as important to many companies but few companies use the possibilities to register designs. It should be investigated if this is linked to the definition and requirements for protection of designs, or the role of functionality.

Please indicate which industry sector views are included in part “**III. Proposals for harmonization**” of this form:

#### Summary

Swedish law provides for protection of the outward appearance or ornamentation of an object or article of manufacture as registered design. The requirements for such a right are novelty and individual character. A design right does not include details that are directed solely by the technical function of that product. Factors that are to be taken into consideration when determining whether a design or part of a design have technical function are whether the overall appearance as well as the portions of the overall appearance are dictated solely by their technical function, whether there are alternative appearances that can obtain the same technical result, whether the need to achieve the product’s technical function was the only relevant factor when the design was selected and whether the design is qualified and given special care. Portions of a design that are functional can be denied design protection but this does not mean that the rest of the product is unprotectable. The effect on the scope of protection of a design with one or more functional portions has not been tried in case law in Sweden. It is likely that functional parts will not be taken into account when assessing infringement or validity, at least not separately. Swedish and EU law are sufficiently clear and the group sees no need for improvement. The group is of the opinion that harmonization is desirable. A harmonized definition is desirable but it is not absolutely necessary to harmonize the word used, only its meaning . The requirements for such a right should be novelty and individual character. Technical functions in a design or parts thereof should not be protectable via design rights and the factors used in Swedish and EU law should be used in determining whether a design or parts thereof are functional. The effect on the scope of protection of a design with functional portions should be that such portions are not taken into consideration separately when assessing infringement or validity but that the parts can play a role in the overall comparison. Another possibility could in the group’s view be to not let functionality have effect as long as the overall appearance of a design is not dictated solely by its technical function.